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No. 96-1271

In The

Supreme Court of the United States

October Term, 1996

PERRY W. GUINN, GARY N. MILLS,
ROBERT A. BEDIENT and MARTIN O. GREELEY,

Petitioners,

vs.

HENRY B. KOPF,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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RESPONDENT'S BRIEF IN OPPOSITION

Respondent Henry B. Kopf requests that the Court deny the Petition for Writ of Certiorari seeking review of the judgment of the United States Court of Appeals for the Federal Circuit. The opinion of the Court of Appeals for the Federal Circuit is reported at 96 F.3d 1419 (Fed. Cir. 1996).

STATEMENT OF THE CASE

Interference No. 103,096 was declared by the United States Patent and Trademark Office ("PTO") on February 16, 1993, between two pending United States patent applications of Henry B. Kopf ("Respondent"), both of which have been accorded the benefit of a filing date of November 26, 1986, and an issued United States patent of Perry W. Guinn, et al., ("Petitioners"), which has an effective filing date of May 12, 1986. Claims 19-31 and 20-38, respectively, of the two Kopf applications and claim 9 of the Guinn et al. patent were designated as corresponding to the sole "count" of the interference (defining the inventive subject matter claimed by both parties). Both the Kopf applications and the Guinn, et al., patent relate to bioreactor apparatus systems.

On October 13, 1994, Guinn, et al., filed a disclaimer under 35 U.S.C. § 253 of claim 9 of the patent, the only claim corresponding to the count, together with a motion to dismiss the interference for lack of jurisdiction. The disclaimer included a statement that "[t]his disclaimer is not a request for entry of an adverse judgment under 37 C.F.R. § 1.662," contrary to part (c) of 37 C.F.R. § 1.662, which provides (emphasis added):

> The filing of a statutory disclaimer under 35 U.S.C. § 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee *unless it results in the deletion of all patent claims corresponding to a count.*

Guinn, et al., timely filed a response to an order to show cause on November 4, 1994, contending that the Board had no jurisdiction to enter judgment, and that 37 C.F.R. § 1.662(c) was invalid. The Board held that Kopf was entitled to priority and issuance of patents on his applications involved in the interference. The United States Court of Appeals for the Federal Circuit affirmed the decision of the Board, and the Petition for Certiorari by Guinn, et al., followed.

SUMMARY OF THE ARGUMENT

The filing of a statutory disclaimer by a patentee of all patent claims corresponding to a count in an interference does not divest the Board of Patent Appeals and Interferences of the jurisdiction to enter a final judgment adverse to the patentee and in favor of an applicant. The Board has statutory jurisdiction of an interference despite such disclaimer.

37 C.F.R. § 1.662(c) provides that when a disclaimer by a patentee of all patent claims corresponding to a count is filed, the filing of the disclaimer will be treated as a request for entry of an adverse judgment. Contrary to Petitioners' argument, entry of the disclaimer does not

extinguish all controversy between the parties in interference because it does not, *inter alia*, resolve the issue of whether the junior party Respondent is entitled to a patent on its claims in interference. The Board therefore retains post-disclaimer jurisdiction to enter judgment in the interference.

Further, the regulation 37 C.F.R. § 1.662(c) is not inconsistent with the disclaimer statute, 35 U.S.C. § 253 because such regulation merely states how a judgment will be entered in the event a patentee exercises its right to file a disclaimer. Hence, the regulation is entirely consistent with the PTO's statutory mandate to administer the Patent Laws, and has been properly promulgated by the Commissioner of Patents and Trademarks. See, e.g., *Petrie v. Welsh*, 21 USPQ 2d 2012, 2013 (Bd. Pat. App. & Int. 1991) (interference terminated for lack of subject matter jurisdiction where patent had expired prior to declaration of the interference). See also *Perkins v. Kwon*, 886 F.2d 325, 328, 12 USPQ 2d 1308, 1311 (Fed. Cir. 1989) (Board properly decided priority issue despite determination that the invention was not patentable to one of the parties); and *United States ex rel. Newcomb Motor Co. v. Moore*, 30 D.C. App. 464, 476 (1908) (holding, in a case under former statute and not involving a disclaimer, that "the jurisdiction of the Commissioner attaches when he directs the declaration of an interference, and he still retains jurisdiction to award priority to the successful party after his adversary has been eliminated. It would indeed be an anomalous situation, if his determination that one party to an interference has no right to make the claims in issue, and therefore is not entitled to a judgment of priority, operates to deprive him of jurisdiction to award priority to the other party, who has the right to

make the claims in issue, and who is entitled to an award of priority."), *cert. denied*, 216 U.S. 608 (1910).

The Petitioners have failed to establish any conflict between the regulation, 37 C.F.R. § 1.662(c), and the statute. 37 C.F.R. § 1.662(c) therefore has the force and effect of law, *Norton v. Curtiss*, 433 F.2d 779, 791, 167 USPQ 532, 542 (CCPA 1970), and the Board properly entered judgment pursuant to 37 C.F.R. § 1.662(c).

37 C.F.R. § 1.662(c) is entirely consistent with the statutory mandate of 35 U.S.C. § 6(a) to implement the patent statute, by providing a mechanism for the Board to determine priority and patentability of inventions in interferences as required by 35 U.S.C. § 7(b). Under 35 U.S.C. § 135(a), the conditions under which an interference may be declared or initiated are specified. Section 135(a) does not limit the duration of an interference, but states, inter alia, that "*the Commisioner may* issue a patent to the applicant who is *adjudged* the prior inventor" (emphasis added). 37 C.F.R. § 1.662(c) therefore validly specifies how an interference is terminated in the case where one party statutorily disclaims all patent claims corresponding to a count.

When 37 C.F.R. § 1.662(c) was originally proposed in 1984, it did not provide for the entry of adverse judgment if a party-patentee filed a statutory disclaimer. Rather, as proposed, the rule read as follows:

> (c) The filing of a statutory disclaimer under 35 U.S.C. § 253 by a patentee will not be construed as a request for entry of an adverse judgment against the patentee, but will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer of any claim involved in an interference

> shall in subsequent proceedings have the same effect with respect to the patentee as an adverse judgment.

See Notice of Proposed Rulemaking, Patent Interference Proceedings, 49 Fed. Reg. 3768, 3798 (Jan. 30, 1984), *reprinted in* 1039 Off. Gaz. Pat. Office 11, 122 (Feb. 14, 1984).

In view of the comments received from the public in response to the Notice of Proposed Rulemaking, 37 C.F.R. § 1.662 was changed to its present form, providing that the filing by a patentee of a statutory disclaimer of all claims of the patent corresponding to the count will be treated as a request for adverse judgment. The reason for the change was set out in the Final Rule:

> Several comments discussing § 1.662 were received. Two comments suggested a change be made to provide that when a patentee files a statutory disclaimer under 35 U.S.C. § 253 and deletes *all* claims corresponding to a count, the disclaimer will be treated as a request for judgment. As one of the comments pointed out, "[s]ince . . . [the filing of a statutory disclaimer disclaiming all claims corresponding to a count] by the patentee could have no other conceivable effect, the proposed rule should be changed to require judgment when all corresponding claims are disclaimed." The suggestion has been adopted and appropriate changes have been made to § 1.662(c). In view of the changes, the following language in § 1.662(c), as proposed, is not necessary: "A statutory disclaimer of any claim involved in an interference shall in subsequent proceedings have the same effect with respect to the patentee as an adverse judgment."

Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416, 48447 (Dec. 12, 1984), *reprinted in* 1050 Off. Gaz. Pat. Office 385, 416 (Jan. 29, 1985) (hereafter "Final Rule").

When the present interference rules were adopted in 1984, the Commissioner stated:

> The object of the interference will be to resolve all controversies as to all interfering subject matter defined by one or more counts. A final decision in the interference will determine who, if anyone, is entitled to claims which correspond to a count.

Final Rule at 48416, 1050 Off. Gaz. Pat. Office at 385. *See also Perkins v. Kwon*, 886 F.2d at 327-28, 12 USPQ 2d at 1310-11. The Commissioner's objective, and that of 35 U.S.C. § 135(a), to resolve all controversies would be frustrated if a patentee involved in an interference could obtain "dismissal" of the interference without judgment by filing a statutory disclaimer. To prevent such an occurrence, the Commissioner has properly exercised his rulemaking authority in promulgating 37 C.F.R. § 1.662(c), ensuring that ultimate resolution of the interference will be "final" as between the parties. The rule is not inconsistent with any statute, but rather is designed to make certain that every interference will result in a final determination of the issues involved.

In 1985, the Patent Law was amended in 35 U.S.C. § 135(a) to provide that "[t]he Board of Patent Appeals and Interferences shall determine questions of priority . . . and may determine questions of patentability."

A party during the pendency of an interference proceeding may request entry of adverse judgment at any time (37 C.F.R. § 1.601(l)). A disclaimer of all claim(s) corresponding to the count is treated as a request for entry of adverse judgment under 37 C.F.R. § 1.662(a).

The *raison d'etre* of an interference proceeding is to declare which of competing claimants is entitled to patent the subject matter (defined by the count) in controversy. Under 37 C.F.R. § 1.662(c), a party filing a disclaimer of claim(s) corresponding to the count is relinquishing the patentee's right (if any) to the subject matter in controversy. Such disclaimer has no effect on the issue of who in fact among the initial competing claimants to the subject matter of the count is the first inventor. That issue remains for the determination of the Board.

The Petitioners would have the action of filing a statutory disclaimer function to deprive the Board of Patent Appeals and Interferences of any ability to declare (by judgment) the consequences inexorably flowing from such unilateral action of a party. Simply stated, the Petitioners contend that the Board in such instance is fully deprived of the right and authority to declare judgment.

The Petitioners instead would have the power of the Board to declare judgment vanish when claims corresponding to a count are disclaimed by a party to the interference. The Board then would be powerless to award judgment and the interference proceeding would simply dissolve.

Such unilateral termination and indeterminate end of interference proceedings, however, would be wholly at

odds with the decisional scheme of administrative determination lawfully vested by statute and enabling Federal regulations in the Patent and Trademark Office Board of Patent Appeals and Interferences.

REASONS FOR DENYING THE WRIT

I. THE FEDERAL REGULATION (37 C.F.R. § 1.662(c)) ATTACKED BY PETITIONERS IS VALID AND CONSISTENT WITH TITLE 35 OF THE UNITED STATES CODE

35 U.S.C. § 7(b) provides for determination of priority and patentability of invention by the Patent and Trademark Office Board of Patent Appeals and Interferences in interferences declared under 35 U.S.C. § 135(a) between competing claimants to the same patentable invention.

Consistent therewith, the declaration by the PTO of an interference *prima facie* establishes that two or more parties claim the same patentable invention. See *Conservolite Inc. v. Widmayer,* 21 F.3d 1098 (Fed.Cir. 1994).

The preamble of 37 C.F.R. § 1.601 states that the purpose of the interference rules under the Code of Federal Regulations is "to secure the just, speedy, and inexpensive determination of every interference."

To effectuate such process, Congress has granted the Commissioner of Patents and Trademarks extremely broad powers over PTO practice. 35 U.S.C. § 6 states in part that the Commissioner "shall superintend or perform all duties required by law respecting the granting

and issuing of patents." Such power includes the discretion to promulgate regulations governing the conduct of proceedings, including interferences, before the PTO. See *Gerritsen v. Shirai*, 979 F.2d 1524 (Fed. Cir. 1992).

37 C.F.R. § 1.662(c) permits a party filing a statutory disclaimer of patent claims in an interference proceeding before the Patent and Trademark Office to thereby remove those claims from the proceeding. If all patent claims corresponding to the interference "count" that define the contested subject matter in an interference are disclaimed by a party, the disclaimer operates as a request for entry of judgment against the disclaiming party.

The Petitioners urge that 37 C.F.R. § 1.662(c) is invalid as an exercise of the Commissioner of Patents and Trademarks' power conferred by 35 U.S.C. § 6(a) to establish "regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office." Such position is based on an asserted inconsistency between 37 C.F.R. § 1.662(c) and 35 U.S.C. § 253, the latter providing that a patent holder "may, on payment of the fee required by law, make disclaimer of any complete claim" of a patent.

There is, however, no facial discord or operational incongruity between 37 C.F.R. § 1.662(c) and 35 U.S.C. § 253. The statute in § 253 is permissive of the patent holder's right to disclaim ("may . . . make disclaimer"). There is no coercion on a patent holder to take such disclaiming action, in patent interference proceedings or otherwise.

Moreover, in granting the patent holder the right to disclaim, 35 U.S.C. § 253 does not in any way limit or constrain the Commissioner of Patents and Trademarks, or the PTO, in the *procedural effect* of such disclaimer in interference proceedings involving the patent.

In application to patent interference proceedings, the grant by Congress of regulation-promulgating authority to the Commissioner of Patents and Trademarks under 35 U.S.C. § 6(a) must be read consistently with the provisions of 35 U.S.C. § 7(b), providing, in pertinent part, that:

> "[t]he Board of Patent Appeals and Interferences . . . ***shall determine*** priority and patentability of invention in interferences declared under section 135(a) of this title." (emphasis added)

Such Congressionally conferred jurisdiction of the board of Patent Appeals and Interferences is properly effectuated by relevant provisions of the Code of Federal Regulations.

37 C.F.R. § 1.606 requires, as a precedent condition of the ripeness of the priority and patentability issues to be determined by the Board between a patent application and an unexpired patent, that a Patent and Trademark Office Examiner must first establish "that there is interfering subject matter claimed in the application and the patent *which is patentable to the applicant subject to a judgment in the interference*" (emphasis added).

37 C.F.R. § 1.608(b), consistently, requires that "the [patent] applicant, before an interference will be declared, shall file evidence which may consist of patents or

printed publications, other documents, and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee and an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment."

These regulations, 37 C.F.R. § 1.606 and 37 C.F.R. § 1.608(b), have been promulgated by the Commissioner of Patents and Trademarks as threshold requirements for commencing an interference proceeding. These regulations have not been attacked by the Petitioners as invalid or as inconsistent with statutory authority.

The Petitioners therefore appear to fully accept the precept that the Commissioner may under the provisions of 35 U.S.C. § 6(a) establish conditions for *initiating* interference proceedings. Nonetheless, Petitioners contrarily argue that the Commissioner cannot establish conditions for *procedurally concluding* interference proceedings within the statutory mandate of 35 U.S.C. § 7(b) (the Board "shall determine priority and patentability of invention in interferences") and the broad statutory permission in 35 U.S.C. § 253 (granting the patent holder the right to "make disclaimer of any complete claim" of a patent, in interference proceedings or under any other circumstances).

The Petitioners' position therefore is fundamentally at odds with the broad authority vested by 35 U.S.C. § 6(a) in the Commissioner of Patents and Trademarks to "establish regulations . . . for the conduct of proceedings in the Patent and Trademark Office."

No facial or operative inconsistency has been shown by Petitioners between 35 U.S.C. § 253 and 37 C.F.R. § 1.662(c). None exists. These statutory and regulatory provisions properly comport with the administrative rule-making power of the Commissioner conferred by Congress in 35 U.S.C. § 6(a).

II. THE PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES HAS VALID JURISDICTION TO ENTER THE JUDGMENT ATTACKED BY PETITIONERS.

35 U.S.C. § 6 grants the Commissioner of Patents and Trademarks broad jurisdiction over patent matters, stating in pertinent part that the Commissioner "shall superintend or perform all duties required by law respecting the granting and issuing of patents." 35 U.S.C. § 6(a). Congress has granted the Commissioner extremely broad powers over Patent and Trademark Office practice, which include the discretion to promulgate regulations governing the conduct of proceedings before the PTO, including interferences. See, e.g., *Gerritsen v. Shirai*, 979 F.2d 1524 (Fed. Cir. 1992).

As discussed in the preceding section of this Brief, there are operative threshold requirements under the Code of Federal Regulations for the conduct of patent interference proceedings. These jurisdictional procedural requirements include the requirement of 37 C.F.R. § 1.606 that a Patent and Trademark Office Examiner first establish "that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference" as

well as the requirement of 37 C.F.R. § 1.608(b) that the patent applicant "file evidence . . . and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment . . . and . . . the basis [therefor]."

Such requisites ensure that the Board of Patent Appeals and Interferences is jurisdictionally situated to carry out its statutory duty under 35 U.S.C. § 7(b) to "determine priority and patentability of invention in interferences."

Petitioners have argued that their disclaimer of the contested subject matter during the interference proceeding has the operative effect of depriving the Board of any jurisdictional ability to declare that Petitioners are not entitled to a patent claiming the contested subject matter they have disclaimed.

A judgment in an interference has a preclusive effect in subsequent PTO proceedings. 37 C.F.R. § 1.658(c). More specifically, a judgment in an interference settles all issues which:

(1) were raised and decided in the interference,

(2) could have been properly raised and decided in the interference by a motion under 37 C.F.R. § 1.633(a)-(d) and (f)-(j), or 37 C.F.R. § 1.634 or

(3) could have been properly raised and decided in an additional interference with a motion under § 1.633(e). *Id.*

The termination of interferences with a judgment achieves administrative decisional economy, permitting conclusive determination of issues susceptible of resolution in an interference forum.

It is in the PTO's interest and in the public interest that a determination of priority and patentability of invention is final and conclusive in every interference proceeding. If adverse judgments were prevented from being entered in interference proceedings under the provisions of 37 C.F.R. § 1.662(c), patent holders might otherwise be motivated to reinitiate interference proceedings, relitigate issues currently committed to the decisional role of the Board for final determination, and/or unilaterally withdraw from interference proceedings upon anticipation of a possible negative outcome, to avoid the fact and consequence of a disfavorable judgment.

III. PETITIONERS HAVE GROSSLY MISCHARACTERIZED THE PROCEEDINGS BEFORE THE PATENT AND TRADEMARK OFFICE, BY ARGUING THE ABSENCE OF A RECORD OF PATENTABILITY DETERMINATION; THERE IS SUCH A RECORD, AND PETITIONERS ACTIVELY PARTICIPATED IN MAKING IT

The Petitioners have argued, as a predicate for their attack on the Board's decision for which they seek review, that *"no issues of patentability of the involved application claims* [of Respondent's patent applications] *have been fully developed on the record of the interference* before the Board of Patent Appeals and Interferences" (emphasis added; Petition, page (i)).

The Petitioners therefore challenge the ability of the Board to hold that Respondent is entitled to a patent on the patent application claims in the interference, *"in the absence of a record"* (emphasis added; Petition, page (i)).

The crux of the Petitioners' case – depending on which portion of the Petition's Question 3 ("Questions Presented" at page (i) of the Petition) receives attention – is either that "no issues of patentability [of Respondent's claims] have been fully developed on the record of the interference," or that the Board's holding of Respondent's entitlement to patent the subject matter in interference was made "in absence of a record." Regardless of which of these "no record" and "no fully developed record" characterizations is examined, the Petitioners' contention of inadequacy of the record of patentability does not survive close scrutiny.

As mentioned in the preceding section of this Brief, 37 C.F.R. § 1.606 requires that for interference proceedings to commence between a patent application and an issued patent, a Patent and Trademark Office Examiner must first establish "that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference."

37 C.F.R. § 1.608(b) additionally requires a *prima facie* showing by a patent applicant as a threshold requirement for an interference proceeding, *viz.*, that the patent applicant "file evidence . . . and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment . . . and . . . the basis [therefor]."

These events must occur in the Patent and Trademark Office before a patent interference proceeding can begin. These events require evidence, *on the record,* for each patent application that is involved in the interference proceeding.

In the interference here involved, the Examiner charged with the responsibility of determining contingent patentability (subject to the final decision in the interference) of the claims in Respondent's patent applications had rigorously examined such applications. The Examiner had considered prior art and arguments for patentability of the Respondent's claims, and the Examiner had concluded that the Respondent's applications containing such claims were of appropriate form for the interference proceeding.

On October 9, 1992, the Examiner issued a communication in each of Respondent's involved applications – Paper No. 18 in Respondent's U.S. Patent Application No. 07/442,240, and Paper No. 10 in Respondent's U.S. Patent Application No. 07/207,655 – copies of which are attached in Appendices A and B of this Brief, respectively. In such communications, the Examiner, stating that "[a]pplicant must fully comply with 37 C.F.R. 1.608(b)," required affidavit evidence and "an explanation stating with particularity the basis upon which the applicant would be *prima facie* entitled to the judgment" in an interference with the Guinn, et al. (Petitioners') patent.

On the basis of the resulting record in the Patent and Trademark Office proceedings, an interference was declared, in which Petitioners subsequently took a full and active part. It is noted here that Petitioners have not complained of being foreclosed from participation in the interference proceeding. They have not expressed concern that their due process rights of involvement in the interference were truncated. Petitioners have argued

simply that the Board did not have an appropriate record of patentability of the Respondent's patent application claims, on which to base a decision in the interference.

This position is taken by Petitioners, despite the fact that Petitioners are not contesting the rigor or propriety of the patentability determination made by the Examiner *in which the Examiner concluded, consistent with the requirements of 37 C.F.R. § 1.606, that the interfering subject matter claimed by Respondent is prospectively patentable to the Respondent subject to a final decision in the interference proceeding.*

Accordingly, the Petitioners' position stands or falls on the simple issue of the adequacy of the record of patentability of Respondent's claims before the Board of Patent Appeals and Interferences.

An interference proceeding accommodates a variety of motions during the so-called "motion period" of the interference process. The motions which can be filed by a party to an interference include motions under 37 C.F.R. § 1.633(a). 37 C.F.R. § 1.633(a) specifically permits a party to file a preliminary motion in the interference proceeding, attacking the patentability of an opponent's patent claim:

"§ 1.633 Preliminary motions.

A party may file the following preliminary motions:

(a) A motion for judgment against an opponent's claim designated to correspond to a count on the ground that the claim is not patentable to the opponent. The motion shall separately address each claim alleged

> to be unpatentable. In deciding an issue raised in a motion filed under this paragraph (a), a claim will be construed in light of the specification of the application or patent in which it appears."

In the interference here involved, a Motion for Judgment Pursuant to 37 C.F.R. § 1.633 was filed in the interference by the Petitioners on May 17, 1993 (Paper No. 11 of the interference), with which references A-H were submitted to the Board by Petitioners. The Motion contained arguments that the cited references anticipated under 35 U.S.C. § 102, or rendered obvious under 35 U.S.C. § 103, the claims of Respondent's patent applications corresponding to the count defining the contested subject matter of the interference.

Petitioners also filed a subsequent Motion for Judgment in the interference (Paper No. 21), again urging that the claims of Respondent's applications in the interference were anticipated under 35 U.S.C. § 102 or rendered obvious under 35 U.S.C. § 103.

The Board's Decision on Motions issued on September 29, 1994. The first Motion (Paper No. 11) was denied, and the second Motion (Paper No. 21) was dismissed. In the "Decision on Motions," the references cited by the Petitioners were discussed by the Board.

The Board, in its consideration of the references adduced by the Petitioners, did not determine any substantive basis for holding Respondent's claims invalid. The Petitioners had opportunity to be heard in the interference proceeding, and to present evidence on the issue

of patentability of the Respondent's claims involved in the interference.

The Petitioners therefore actively participated in the proceedings before the Board, and they introduced references urged by them to invalidate the Respondent's patent application claims. The Petitioners' motions filed in the interference proceedings were decided favorably to the patentability of Respondent's claims.

Petitioners now take issue with the Board's judgment in favor of Respondent, and variously argue "the absence of a record" and, curiously and inconsistently, that "no issues of patentability have been fully developed on the record of the interference."

The Petitioners therefore seek by vague allegations of an inchoate record – allegations fully rebutted by the record of Petitioners' involvement in the interference proceeding before the Board – to defeat the Board's judgment by collateral attack on the validity of 37 C.F.R. § 1.662(c).

In fact, the Petitioners in their attempt to have this Court invalidate 37 C.F.R. § 1.662(c) are simply seeking to evade the direct and logical consequence of their own action in disclaiming the subject matter in controversy. That consequence is the Board's judgment against Petitioners, and that judgment is mandated by 35 U.S.C. § 7(b)'s statutory directive to the Board to "determine priority and patentability . . . in interferences."

No basis exists for reversible error in the decision of the Board or in the decision of the United States Court of Appeals for the Federal Circuit affirming the Board's decision.

It therefore is requested that the Petition be denied, so that the Board's decision in the matter is finally effectuated, to permit patents to issue on Respondent's long-pending applications involved in the interference.

CONCLUSION

The Petitioners have grossly mischaracterized the record, in attacking the validity of 37 C.F.R. § 1.662(c) governing the termination of interference proceedings between competing claimants to patentable subject matter in the instance where one party files a terminal disclaimer of all claims corresponding to the count in the patent interference.

The Petitioners have in fact totally ignored the record and the provision of 37 C.F.R. § 1.606 requiring the PTO to determine before an interference is declared that the interfering subject matter of a patent application is patentable to the applicant subject to a judgment in the interference.

The Petitioners also have ignored the procedural provisions of C.F.R. § 1.608 which require an applicant for patent, prior to the declaration of an interference, to file evidence demonstrating that applicant is *prima facie* entitled to judgment relative to the patentee, with an explanation of the particular basis on which applicant is *prima facie* entitled to the judgment (as was done before the U.S. Patent and Trademark Office prior to the initiation of the interference here involved).

Finally, the Petitioners have mischaracterized the record as being devoid of any prior art determination, despite the fact that Petitioners filed Motions for Judgment pursuant to 37 C.F.R. § 1.633(a) in the interference, seeking judgment of unpatentability of Kopf's claims on prior art grounds. The Petitioners therefore seek review by this Court based on their allegations of the lack of a record of patentability determination before the Board, an assertion which is false and inconsistent with the record of this case.

When a patent holder involved in an interference proceeding exercises his right under 35 U.S.C. § 253 to disclaim all involved claims corresponding to the count, he has unequivocally waived his rights to the subject matter of the count. 37 C.F.R. § 1.662(c) merely states the direct and inescapable result of the patentee's action in providing that a disclaimer of all of a patent's involved claims corresponding to a count shall be treated as a request for adverse judgment.

Under 35 U.S.C. § 7, the Board of Patent Appeals and Interferences is vested with authority to receive evidence and determine issues of priority and patentability, and to determine, *inter alia*, any issue of interference in fact as to any count, and any other issue necessary to resolve the interference.

It is fundamental to the governmental processes of an orderly society that the jurisdiction of a tribunal, whether judicial or administrative, be committed in the scheme of governance to achieve final and dispositive results. This objective requires the tribunal to declare a result binding

the parties and resolving the controversy. Were it otherwise, parties could simply unilaterally declare the absence of power and authority binding them at any stage of the proceedings, and withdraw from the matter in controversy, consistent with the intention not to be bound.

That, simply stated, is what Petititoners seek. The Petitioners were under no compulsion to file the disclaimer of the claim in interference. If the Petitioners thought themselves unworthy of receiving adverse judgment, they could have remained and fully and fairly argued their position on the merits to an intended successful conclusion.

The Petitioners now seek by vague allegations of an inchoate patentability record – an allegation which is fully rebutted by the substantive and procedural events involved in this matter – to mount an attack on the validity of 37 C.F.R. § 1.662(c).

By this tactic, the Petitioners seek to evade the just and logical consequence of their own action in disclaiming the subject matter in controversy, namely, a judgment based on the action that Petitioners have taken.

For all these reasons, it is requested that Guinn, et al's Petition for Writ for Certiorari be denied.

Respectfully submitted,

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Appendix A – October 9, 1992 Communication from Supervisory Primary Examiner James C. Housel of Group 180 of U.S. Patent and Trademark Office in U.S. Patent Application No. 07/442,240 of Henry B. Kopf (Paper No. 18)

APPENDIX A

[SEAL]

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER
07/442,240

FILING DATE
11/28/89

FIRST NAMED APPLICANT
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EXAMINER
HOUSEL, J

ART UNIT
1809

PAPER NUMBER
18

DATED MAILED:
10/09/92

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ONE MONTH~~S, DAYS~~ FROM THE DATE OF THIS LETTER.

Applicant is advised, as per the previous Interview Summary Record, that an interference has proposed between the instant application and Guinn et al., U.S. Patent 4,889,812. Since the effective filing date of the instant application is more than three months after the filing date of the Guinn et al. patent, Applicant must fully comply with 37 CFR 1.608(b). While the affidavit filed 4/18/91 under 37 CFR 1.131 may be intended to comply with the rule, §1.608(b) further requires:

> (1) affidavits by one or more corroborating witnesses, i.e., witnesses other than the applicant; with each affidavit setting out a factual description of acts and circumstances performed or observed by the affiant, and
>
> (2) an explanation stating with particularity the basis upon which the applicant would be *prima facie* entitled to the judgment.

Applicant is therefore required to furnish the above-noted documentation before an interference can be declared. Failure to timely submit the above-noted documentation in compliance with 37 CFR 1.608(b) will result in abandonment of the instant application. Extensions of time for the filing of the response may be obtained in accordance with 37 CFR 1.136(a).

/s/ James C. Housel 10/9/92

JAMES C. HOUSEL
SUPERVISORY PATENT
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GROUP 180

Appendix B – October 9, 1992 Communication from Supervisory Primary Examiner James C. Housel of Group 180 of U.S. Patent and Trademark Office in U.S. Patent Application No. 07/207,655 of Henry B. Kopf (Paper No. 10)

APPENDIX B

[SEAL]

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER
07/207,655

FILING DATE
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1809

PAPER NUMBER
10

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Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ONE MONTH~~S, DAYS~~ FROM THE DATE OF THIS LETTER.

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/s/ James C. Housel 10/9/92

JAMES C. HOUSEL
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